



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,878	03/06/2002	Michael R. Schramm		2526

7590 12/12/2005  
Michael R. Schramm  
350 West 2000 South  
Perry, UT 84302

EXAMINER

LAMB, BRENDA A

ART UNIT PAPER NUMBER

1734

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER
----------

ART UNIT	PAPER
----------	-------

122005

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

The reply filed on 9/22/2005 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): In the amendment filed 9/22/2005, applicant has added benefit under 35 U.S.C. 120 to additional US applications as set forth at lines 2-9 of the specification insert set forth in the instant amendment yet applicant has failed to provide with the amendment a petition under 37 CFR 1.78(a)(3) or (a)(6) along with surcharge as is required to add the benefit claim at this time period after filing of the application. See the attached pages which include MPEP 201.11 Part F (Correcting or Adding a Benefit Claim After Filing). See 37 CFR 1.111. Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication should be directed to Brenda A. Lamb at telephone number (571) 272-1231 and inquiry as to how to file the petition under 37 CFR 1.78 (a)(3) or (a)(6) should be directed to the Inventors Assistance Center at (800) 786-9199.

**BRENDA A. LAMB**  
**PRIMARY EXAMINER**

information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11

#### Examiner Note

In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), a specific reference in the first sentence(s) of the specification, or in an application data sheet, to the prior application is not required and may not be made. The specific reference requirement of 35 U.S.C. 120 is met by the transmittal request for the CPA which is considered to be part of the CPA. 37 CFR 1.53(d)(2)(iv) and (d)(7).

<

If the examiner is aware of a prior application he or she should note it in an Office action, as indicated above, but should not require the applicant to call attention to the prior application.

\*\*

For notations to be placed \*>in< the file \*>history< in the case of continuing applications, see MPEP § 202.02 and § 1302.09.

#### F. Correcting or Adding a Benefit Claim After Filing

The Office will not grant a request for a corrected filing receipt to include a benefit claim unless the proper reference to the prior application is included in the first sentence(s) of the specification or an ADS within the time period required by 37 CFR 1.78(a) >with a few exceptions. See subsection V., "TIME PERIOD FOR MAKING A CLAIM FOR BENEFIT UNDER 37 CFR 1.78(a)(2) AND (a)(5)"<. If the proper reference was previously submitted, a copy of the amendment, the first page of the specification, or the ADS containing the benefit claim should be included with the request for a corrected filing receipt. The Office plans to notify applicants on or with the filing receipt that a benefit claim may not have been recognized because the benefit claim was improper but applicants are advised that only the benefit claims that are listed on the filing receipt have been recognized by the Office. Therefore, applicants should carefully and promptly review their filing receipts in order to avoid the need for a petition (37 CFR 1.78(a)(3) or (a)((6)) and the surcharge.

If a benefit claim is added after the time period required by 37 CFR 1.78(a), a petition and the surcharge are required. See subsection V. "TIME PERIOD FOR MAKING A CLAIM FOR BENEFIT 37 CFR 1.78(a)(2) AND (a)(5)." Any petition under 37 CFR 1.78(a)(3) or (a)(6) must be accompanied by an amendment to the specification or an ADS unless the proper reference was previously submitted. In addition to the petition under 37 CFR 1.78 and the amendment or ADS, to add a benefit claim it may be necessary for applicant to file one of the following, depending on the status of the application:

- (A) a request for continued examination (RCE) under 37 CFR 1.114, if the application is under a final rejection or has been allowed (see MPEP §706.07(h)). An amendment or ADS filed after final rejection or allowance is not entered as a matter of right and must be filed in compliance with 37 CFR 1.116 or 1.312, respectively; or
- (B) a reissue application or a request for a certificate of correction under 37 CFR 1.323, if appropriate (see MPEP § § 1402 and 1481), if the application has

issued as a patent.

An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim after the filing date of the application, the amendment would not be proper. When a benefit claim is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application unless an incorporation by reference statement of the prior application was presented upon filing of the application. See *Dart Indus. v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980).

#### G. Deleting Benefit Claims

Effective June 8, 1995, Public Law 103-465 amended 35 U.S.C. 154 to change the term of a patent to 20 years measured from the filing date of the earliest U.S. application for which benefit under 35 U.S.C. 120, 121, or 365(c) is claimed. The 20-year patent term applies to all utility and plant patents issued on applications filed on or after June 8, 1995. As a result of the 20-year patent term, it is expected, in certain circumstances, that applicants may cancel their claim to priority by amending the specification or submitting a new application data sheet (no supplemental declaration is necessary) to delete any references to prior applications.

The examiner should consider whether any new prior art may now be available if a benefit claim is deleted. If an applicant is submitting an amendment to the specification or an ADS to delete a benefit claim after final rejection or action, the amendment or ADS will be treated under 37 CFR 1.116 (see MPEP § 714.12 and § 714.13). If the amendment or ADS to delete a benefit claim is submitted after the application has been allowed, the amendment or ADS will be treated under 37 CFR 1.312 (see MPEP § 714.16). A deletion of a benefit claim will not delay the publication of the application unless the amendment or ADS is recognized by the Office within nine weeks prior to the projected publication date that was originally calculated based on the benefit claim.

A cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional.

In a continued prosecution application (CPA) filed under 37 CFR 1.53(d), no amendment may delete the specific reference to a prior application assigned the same application number. (Note: In the CPA, the request is the specific reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to every application assigned the same application number identified in the request. Further, in a CPA, a specific reference in the first sentence(s) of the specification following the title, or in an application data sheet, to a prior application assigned the same application number is not required and should not be made.) \*\* The correction or entry of the data in the PALM data base can be made by technical support staff of the TC. Upon entry of the data, a new PALM bib-data sheet should be printed and placed in the file. See also MPEP § 707.05 and § 1302.09.

#### IV. SAME INVENTOR OR INVENTORS

The statute also requires that the applications claiming benefit of the earlier filing date under 35 U.S.C. 119(e) or 120 be filed by an inventor or inventors named in the previously filed application or provisional application. 37 CFR 1.78(a)(1) and (a)(4) require that each prior-filed application must name as an inventor at least one inventor

named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112.<

#### **V. TIME PERIOD FOR MAKING A CLAIM FOR BENEFIT UNDER 37 CFR 1.78(a)(2) AND (a)(5)**

**The time period requirement under 37 CFR 1.78(a)(2) and (a)(5) is only applicable to utility or plant applications filed on or after November 29, 2000.**

The American Inventors Protection Act of 1999 (AIPA), Public Law 106-113, amended 35 U.S.C. 119 and 120 to provide that the Office may set a time period for the filing of benefit claims and establish procedures to accept an unintentionally delayed benefit claim. The Office has implemented these statutory changes, in part, by amending 37 CFR 1.78 to include: (A) a time period within which a benefit claim to a prior nonprovisional or provisional application must be stated or it is considered waived; and (B) provisions for the acceptance of the unintentionally delayed submission of a claim to the benefit of a prior nonprovisional or provisional application.

If the application is \*>a utility or plant< application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the benefit claim of the prior application >under 35 U.S.C. 119(e), 120, 121, or 365(c)< must be made during the pendency of the application and within the later of four months from the actual filing date of the >later-filed< application or sixteen months from the filing date of the \*>prior-filed< application. If the application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, the benefit claim must be made within the later of: (1) four months from the date on which the national stage commenced under 37 U.S.C. 371(b) or (f); or (2) sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c).

If the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) is not submitted within the required time period, a petition for an unintentionally delayed claim may be filed. The petition must be accompanied by: (A) the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to the prior application (unless previously submitted); (B) a surcharge under 37 CFR 1.17(t); and (C) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. See 37 CFR 1.78(a)(3).

Likewise, if the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5) is not submitted within the required time period, a petition for an unintentionally delayed claim may be filed. The petition for an unintentionally delayed benefit claim must be submitted during the pendency of the nonprovisional application. The petition must be accompanied by: (A) the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5) to the prior provisional application (unless previously submitted); (B) a surcharge under 37 CFR 1.17(t); and (C) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. See 37 CFR 1.78(a)(6).

Petitions for an unintentionally delayed benefit claim should be forwarded to the Office of Petitions. See MPEP § 1002.02(b).

\*\*

If an applicant includes a claim to the benefit of a prior application elsewhere in the